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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/601,152	09/05/2000	Markus Weisbeck	MO-5845/LEA3	6993

157 7590 10/16/2002

BAYER CORPORATION
PATENT DEPARTMENT
100 BAYER ROAD
PITTSBURGH, PA 15205

EXAMINER

JOHNSON, EDWARD M

ART UNIT	PAPER NUMBER
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1754

13

DATE MAILED: 10/16/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No.	Applicant(s)
	09/601,152	WEISBECK ET AL.
Examiner	Art Unit	
Edward M. Johnson	1754	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 August 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b])

- a) The period for reply expires 4 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MP&P 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. The proposed amendment(s) will not be entered because:
 - (a) they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) they raise the issue of new matter (see Note below);
 - (c) they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. Applicant's reply has overcome the following rejection(s): _____.
4. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. The a) affidavit, b) exhibit, or c) request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. For purposes of Appeal, the proposed amendment(s) a) will not be entered or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 6-12.

Claim(s) withdrawn from consideration: _____.

8. The proposed drawing correction filed on _____ is a) approved or b) disapproved by the Examiner.

9. Note the attached Information Disclosure Statement(s)(PTO-1449) Paper No(s). _____.

10. Other: _____.


 Stanley S. Silverman
 Supervisory Patent Examiner
 Technology Center 1700

Continuation of 2. NOTE: Proposed new claim 13, which would replace the instant claim 7, includes regeneration with a dilute acid having a pH of 5.5-6.0, the entirety of which is a new issue requiring further search and/or consideration. Also, the proposed amendment to claim 11 would transform the claim into a Jepson claim, creating a new issue that would require further search and/or consideration. Finally, the amendment to claims 8 and 9 to regenerate the activity of the catalyst rather than the catalyst itself would also be a new issue requiring further search and/or consideration.

Continuation of 5. does NOT place the application in condition for allowance because: It is argued that in regard to claims 6 and 9-1, Muller et al. disclose a catalyst which is composed of titanium or vanadium silicalite -and one or more platinum metals-. Applicant claims gold particles and Muller discloses a catalyst with a gold modifier (see column 4, lines 33-36). Applicant does not appear to respond to the particular citation by the Examiner, instead focusing on a different disclosure of "platinum metals" found in column 1 and the possibility of gold in column 2. It is argued that it is important to note that there is an "inherent mystery" surrounding the unpredictability of the performance of catalysts. It is further noted that the instant method claim recites catalyst product limitations in the preamble. A preamble generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478 481 (CCPA 1951). It is argued that in order to "arrive at" Applicants' claimed invention, the skilled artisan would have had to ignore the fact that Muller et al. do not even teach or motivate the skilled artisan. This is not persuasive because Applicant appears to admit that Muller discloses titanium silicalite, which is an oxide, and gold; and Applicant claims titanium oxide and gold. Finally, Applicant appears to object to the broad disclosure of different embodiments in Muller. However, it is noted that Applicant also claims various catalysts with open claim language "comprising" wherein the catalyst includes gold and titanium dioxide which may or may not be hydrous. Because of the use of open claim language, embodiments containing other metals are not excluded by the claim. Therefore, contrary to Applicant's apparent suggestion, Applicant's claim is not considered to be far more limited in scope than the disclosure of Muller.